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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/011,167 10/05/98 GEUZE J RILE.001.000

HM22/0817

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EXAMINER

DECLoux, A

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

08/17/01

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/011,167

Applicant(s)

Gueze And Mellef

Examiner

DeCloux, Amy

Art Unit

1644

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED Jul 20, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 7-20-01. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: Applicants have amended claims 9, 11-12 to become product by process claims and therefore part of the elected invention in a second after-final amendment, when said amendments could have been made earlier.

4. ☒ Applicant's reply has overcome the following rejection(s):
The 112 first written description, the 102 and the 112 second paragraph rejections and the objection to the specification. However, the 112 first enablement rejection would be maintained. See attached sheet.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:

7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 2-4, 6, and 13
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

David A. Saunders
DAVID SAUNDERS
PRIMARY EXAMINER
ART UNIT 182-1644

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DETAILED ACTION

1. Applicant's after-amendment, mailed 7-17-01 (Paper No. 22) is acknowledged, but has not been entered because new issues have been raised by amending claims 9 and 11-12 (formerly method claims) to become product by process claims. New searches and further consideration would be required for the process steps of said claims. Further it is not clear why these claims were not amended earlier in prosecution, before the present second after-final amendment.

2. **Maintained** Claims 2-4, 6 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

3. Though applicant's arguments and amendments in the instant after-final have been carefully considered, the 112 first rejection is maintained essentially for the reasons of record. Applicants traverse the rejection and concern of the examiner that the instant specification lacks a working definition of the term "vesicle" in the instant specification, by contending that said term is an art recognized term which refers to a closed membrane shell derived from cell membranes and gives several articles that encompass class II membrane vesicles. However, the examiner is not clear whether this definition of the term "vesicle" includes the endoplasmic reticulum membranes and/or golgi membranes, where class I molecules mature and contact antigen, or additionally, even if the cell membrane could be included. These embodiments of the term "vesicle" may raise potential art rejections.

Applicants further contend that though the instant specification provides exemplified vesicles in which only MHC class II molecules (as opposed to Class I) are identified, the post-filing date Zitvogel article teaches that multivesicular MHCs can comprise MHC Class I and/or Class II molecules. However, it is not clear to the examiner that the vesicles of the Zitvogel reference and those recited by the instant claims are identical and applicant is invited to point out support in the instant specification for said comparison. If said vesicles are identical, then the examiner agrees with applicant that based on the Zitvogel article, one would know how to make and use said vesicle. It is further noted by the examiner that the instant specification must be enabling for the claimed invention and that the amount of enablement required is inversely correlated to the state of the art at the time the invention was made.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy DeCloux whose telephone number is (703) 306-5821. The examiner can normally be reached Monday through Friday from 9:00 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina

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Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Amy DeCloux, Ph.D.
Patent Examiner,
Group 1640, Technology Center 1600
August 16, 2001

David A. Saunders
DAVID SAUNDERS
PRIMARY EXAMINER
ART UNIT 182/1644